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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,511	12/04/2003	Gregory Breyta	ARC920030073US1	2373
23980	7590	11/30/2007		
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C 1400 PAGE MILL ROAD PALO ALTO, CA 94304-1124			EXAMINER VALENROD, YEVGENY	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			11/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,511	Applicant(s) BREYTA ET AL.	
	Examiner Yevgeny Valenrod	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12,15-18,20-27 and 30-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-12, 15-18, 20-27 and 30-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejection of claims 7, 9-12, 15-18, 22-27 and 30-33 under 35 USC 102 is withdrawn in view of applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-18 and 20-21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The said claims depend on claim 14, which has been canceled. It is unclear which steps are involved in the method and the structures of the reagents involved.

Claim 27 recites the limitation "wherein olefinic reactant is selected from isobutylene..." in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim. Dependency of claim 27 is traced back to claim 23, which requires an alicyclic group to be present in the olefin. Select compounds recited in claim 27 including isobutylene lack such a group.

Claims 24-26 recites limitations directed to definitions of R¹, R², R³, R⁴ and R⁵ where all of the above can be hydrogen or other non-ring forming substituents. There is insufficient antecedent basis for this limitation in the claim. Claims 24-26 depend on

claim 23, which limits olefinic moieties to those having an alicyclic ring which includes two of the before-mentioned groups

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 9-12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The said claims include a proviso that when the olefinic reagent is not one of the listed olefinic reagents, R^6 or R^7 are different or taken together to form a ring. Such proviso has not been described in the specification. The examples provided use hexafluoroacetone and representative products on page 19 are obtained from a reaction of hexafluoroacetone.

Claims 7, 9-12 and 37-39 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. On pages 20-21 (paragraph 0056) of the

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specification a limiting definition of R⁶ and R⁷ is provided. The said definition does not include instances where R⁶ and R⁷ are joined together to form a ring.

Claims 22-27, 30-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims include a proviso where the fluorinated carbonyl compound is other than hexafluoroacetone or require the carbonyl compound to be asymmetric. Such a limitation has not been described in the specification. In fact, the examples provided in the specification are limited to those using hexafluoroacetone and representative alkene fluoroalkanol products depicted on page 19 are all obtained via reaction with hexafluoroacetone.

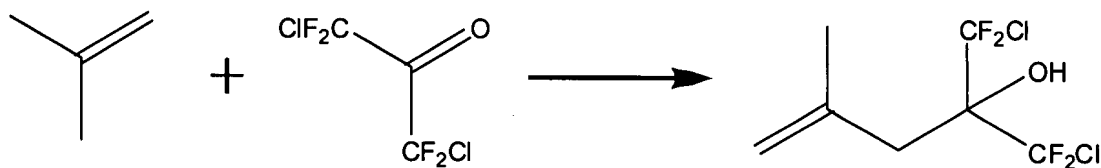
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urry et al (*Journal of Organic Chemistry* **1968** 33(6) pp2302-2310).

Urry et al. teach reaction of 2-methylpropene with 1,3-dichloro-1,1,3,3-tetrafluoropropanone to form a fluorinated addition product. (see scheme below)



Ascertaining the difference between prior art and instant claims

Although the process taught by Urry et al. differs from the instantly claimed process. Instantly claimed process requires an olefin is substituted with a CHR¹R² moiety where R¹ and R² are not both hydrogens. In the example provided by Urry both R¹ and R² are hydrogens.

Obviousness

2-methyl-butene is an olefin reagent included in the scope of claim 22. This reactant is obvious over 2-methylpropene disclosed by Urry et al. The difference between the two reagents is one CH₂ moiety and the two are considered analogous. 2-methylbutene is expected to react in the same way as 2-methylpropene in a carbonyl addition reaction and is therefore obvious over Urry et al. absent unexpected results.

Conclusion

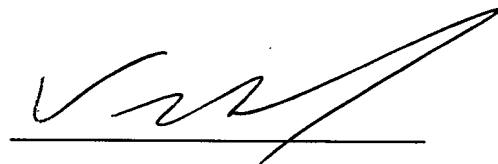
Claims 1-7, 9-12, 15-18, 20-27 and 30-39 are pending.

Claims 1-6 are withdrawn.

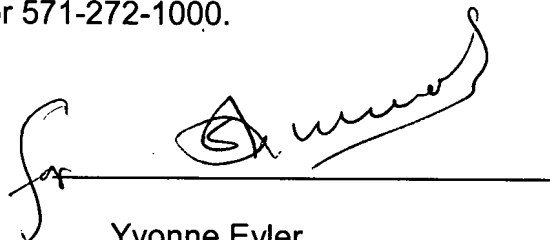
Claims 7, 9-12, 15-18, 20-27 and 30-39 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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